

believe that the method taught in Cheng et al. is suited for evaluating different zinc finger domains. Cheng et al. screened for random peptides that could restore DNA binding and found that none of them were zinc fingers, and emphasized in each case, but one, that the identified peptide "does not resemble a zinc finger." (e.g., at column 17, lines 6-7). One peptide was found to have five of cysteines, but spaced in a manner that in no way resembles a zinc finger domain. Because Cheng et al. failed to show that any zinc finger domain other than the original Sp1 zinc fingers was function its in vivo method, one skilled in the art would not have reason to believe that the in vivo screening would be suitable for identifying a zinc finger domain that recognizes a particular target site. All the identified domains in Cheng et al differed from zinc finger domains, a result suggestive of and consistent with incompatibility. Accordingly, there is no reasonable expectation of success.

In addition, Cheng et al. never verified whether its identified peptides increased transcription in vivo by contacting DNA. Such peptides might operate by other modes, e.g., by causing dimerization or by stabilizing reporter protein activity.

Also, Cheng et al., by identifying peptides that differ from zinc finger domains, teaches away from the alleged combination. Nothing in Cheng et al. suggests that anything but random peptides should be screened. Likewise, nothing in Barbas et al. suggests that its method is inadequate and that one skilled in the art should look to other references to identify a zinc finger domain that recognizes a particular target site. Since neither reference provides a motivation to combine, the alleged combination can only be achieved by impermissible hindsight reconstruction based on the Applicants' specification.

Because the cited references do not support a *prima facie* case of obviousness, the Applicants respectfully submit that the obviousness rejection can be withdrawn. Because the rejection of the remaining claims on page 11 of the Action appears to rely on the same combination of Barbas et al. and Cheng et al., this rejection is also traversed for the reasons above. The Applicants submit that all claims are in condition for allowance, which action is expeditiously requested. The Applicants do not concede any positions of the Examiner that are

Applicant : Jin-Soo Kim et al.  
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Filed : February 16, 2001  
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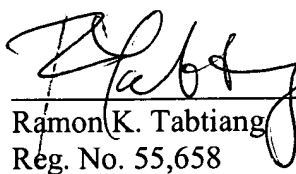
Attorney's Docket No.: 12279-002001

not expressly addressed above, nor do the Applicants concede that there are not other good reasons for patentability of the presented claims or other claims.

Enclosed is a \$510 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 20 December 2005

  
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